

REMARKS

Claims 1, 3-7, 9-13, and 15-20 are pending.

Claims 2, 8, and 14 are cancelled.

In the Office Action mailed June 30, 2009, claims 1, 3-7, 9-12, and 19-20 were rejected under 35 U.S.C. § 101; and claims 1, 3-7, 9-13, and 15-20 were rejected under 35 U.S.C. § 103(a) as unpatentable over Teper (U.S. Patent No. 5,815,665) in view of Grabelsky (U.S. Patent No. 7,480,723).

REJECTION UNDER 35 U.S.C. § 101

Independent claims 1, 7, 19, and 20 have been amended to recite “at least one processor.” Support for the amendment can be found at least in the following passages of the specification: page 6, lines 5-9, 17-22; page 7, lines 23-27.

In view of the foregoing, withdrawal of the § 101 rejection is respectfully requested.

REJECTION UNDER 35 U.S.C. § 103

Independent claims 1, 7, 19, and 20 have been amended to improve their respective form.

It is respectfully submitted that claim 1 is non-obvious over the asserted combination of Teper and Grabelsky.

To make a determination under 35 U.S.C. § 103, several basic factual inquiries must be performed, including determining the scope and content of the prior art, and ascertaining the differences between the prior art and the claims at issue. *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459 (1965). Moreover, as held by the U.S. Supreme Court, it is important to identify a reason that would have prompted a person of ordinary skill in the art to combine reference teachings in the manner that the claimed invention does. *KSR International Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741, 82 U.S.P.Q.2d 1385 (2007).

Although Teper refers to the ability of service providers to provide services such as downloadable software programs to consumers, it is clear that Teper provides no teaching of at least the following elements of claim 1:

receiving, from the user system, a user-specified search value of a search variable directed to a feature indicating a type of software application of at least one service of the services;

querying, by at least one processor, the directory of the plurality of services according to the search value; and

identifying, by the at least one processor, a subset of the services of the directory according to the search value;

The Office Action also conceded that Teper fails to disclose the foregoing elements of claim 1. 06/30/2009 Office Action at 5. Instead, the Office Action cited Grabelsky as purportedly disclosing the subject matter of claim 1 missing from Teper.

The Office Action focused on the discussion of user-specified preferences in Teper as somehow providing a hint to combine Teper with Grabelsky to achieve the claimed subject matter. *Id.* Specifically, the Office Action cited the following passage of Teper: column 3, line 65 – column 4, line 5. The cited passage of Teper refers to an online brokering service that stores and dynamically provides to service provider sites user-specific customization data used by the service providers to customize respective services to individual users, including user-specified preferences for the display of certain types of data, geographic region in which the user resides, and the configuration of the user's computer. However, the reference to user-specific customization data does not provide any hint of receiving a user-specified search value of a search variable directed to a feature **indicating a type of software application of at least one service of the services**, as recited in claim 1.

Grabelsky also fails to provide any hint of the foregoing feature of claim 1. The Office Action cited specifically to column 1, line 57 – column 2, line 3, of Grabelsky, and also to Figs. 7-9 of Grabelsky. The cited passage in columns 1 and 2 of Grabelsky refers to receiving a **call-session request** that includes a **partial destination identifier** that is insufficient to fully define a desired destination identifier. Note that the destination identifier mentioned in Grabelsky is used for establishing an IP telephony call session using SIP messages. Grabelsky, 1:12-53. The call-session request described in

Grabelsky can include a search term that indicates additional information relating to the partial destination identifier. *Id.*, 1:65-2:3.

Figs. 7-9 of Grabelsky depict several flow diagrams that correspond to establishing a call session using a SIP INVITE message. As understood by persons of ordinary skill in the art, the SIP INVITE message is used for establishing an IP-based telephony call session. Grabelsky, 5:48-6:51. A problem that is purportedly addressed by Grabelsky is in the context of a call request for establishing a telephony call session, where the call request contains an incomplete destination identifier that would cause a database lookup to fail. *Id.*, 1:45-53. To address this issue, Grabelsky describes a way of determining possible matches of destination identifiers based on the partial destination identifier of the call request, and sending a response that contains at least a portion of the list of possible matches of destination identifiers. *Id.*, 1:57-65.

However, identifying a correct destination identifier based on a partial destination identifier and based on a search term, as taught by Grabelsky, has nothing to do with the claimed subject matter or the teachings of Teper. Claim 1 specifically recites to receiving a user-specified search value of a search variable directed to a feature indicating the **type of software application** of at least one service of the services. Looking up a destination identifier to complete a telephony call session, as taught by Grabelsky, is simply irrelevant to the claimed subject matter.

In fact, the Office Action conceded that both Teper and Grabelsky fail to disclose receiving a user-specified search value of a search variable directed to a feature indicating a type of software application of at least one service of the services. 08/30/2009 Office Action at 5. Thus, according to this concession of the Office Action, both Teper and Grabelsky fail to disclose querying the directory of the plurality of services according to the search value, and identifying a subset of the services of the directory according to the search value.

Nevertheless, the Office Action argued that the subject matter of claim 1 would be obvious to a person of ordinary skill in the art based on a modification of Teper and Grabelsky to include the claimed subject matter missing from both these references, since doing so “would allow the system to identify a subset of the directory based on the

software application desired.” *Id.*, at 5-6. The Office Action argued that the purported combination would have yielded nothing more than predictable results. *Id.* at 6.

It appears that the rejection made in the Office Action is based on speculation and impermissible hindsight. It is clear that none of the references provide any hint whatsoever of receiving a user-specified **search value** of a search variable directed to a feature indicating a **type of software application**, and then performing querying and identifying based on **such search value**. The only basis for the proposed modification of Teper and Grabelsky made by the Office Action is the teaching of the invention itself. Without the teaching of the invention, a person of ordinary skill in the art would have found absolutely no reason to modify Teper and Grabelsky to achieve the claimed invention. Specifically, Grabelsky relates to identifying a complete destination identifier based on a partial destination identifier so that a call session can be established, which is completely unrelated to the subject matter of claim 1.

Therefore, it is clear that the obviousness rejection of claim 1 is defective since no reason existed that would have prompted a person of ordinary skill in the art to combine the teachings of Teper and Grabelsky to achieve the claimed subject matter. Moreover, it is clear that even if Teper and Grabelsky could be hypothetically combined, the hypothetical combination of references would not have disclosed or hinted at the claimed subject matter.

Independent claims 7, 13, and 19 are similarly allowable over the cited references.

With respect to independent claim 20, the asserted combination of Teper and Grabelsky fails to provide providing a list of a plurality of **categories** of the plurality of services, receiving a selected **category** of the plurality of categories from the user system, receiving a user-specified **search value** of a search variable directed to a feature indicating a **type of software application** of at least one service of the services, querying the directory of the plurality of services according to the search value, and identifying the subset of the directory according to the **search value and to the selected category**.

Dependent claims are allowable for at least the same reasons as corresponding independent claims.

In view of the foregoing, allowance of all claims is respectfully requested.

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The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 08-2025 (200901493-1).

Respectfully submitted,

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